

A2  
Cont

--18. Paper according to claim 1, wherein the screen of the screened image has frequency modulation.--

--19. Paper according to claim 3, wherein the lines are inclined at 45°.--

### REMARKS

Claims 1-19 are pending. By this Amendment, claim 3 is amended and claims 15-19 are added. No new matter has been added.

The attached Appendix includes marked-up copies of each rewritten claim (37 C.F.R. §1.121(c)(1)(ii)).

For at least the following reasons, Applicants respectfully submit that all of claims 1-19 are allowable. Reconsideration of claims 1-19 in view of the foregoing amendments and the following remarks is respectfully requested.

#### **I. RESTRICTION**

In item 1 of the Office Action, a restriction is reasserted. In reply, Applicants affirm the provisional telephone election to prosecute Group I, claims 1-5, with traverse.

It is respectfully submitted that inventions of Groups I and II are related because using a wire is not completely different from a method of making a screened image on a paper because the wire is an element that is conventionally used in the paper industry. The wire here is synonymous with wire work, the mesh work of parallel or woven wire on which the wet web of paper forms (Webster's New Collegiate Dictionary) or the screen on which sheets of paper are formed in a paper making machine (American Heritage Dictionary, College Edition).

It is also respectfully submitted that the subject matter of all claims 1-19 is sufficiently related that a thorough search for the subject matter of any one group would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without

serious burden. See MPEP §803 in which it is stated that "if the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits even though it includes claims to distinct or independent inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

## **II. FORMAL MATTERS**

In item 6 of the Office Action, it is stated that priority was not perfected. Applicants respectfully submit that a certified copy of the foreign priority application was submitted on April 12, 2001, as shown by a stamped PTO receipt for filing of papers attached. Also attached is a copy of the cover page of the French priority document. Thus, Applicants respectfully submit that the claim for priority has been perfected.

In the first item 7 of the Office Action, it is stated that no concise explanation of relevance of the French and European references was provided. Such is incorrect, the English translation of the Search Report indicates that both references are category A, that is background to at least one claim or the technology. Such is a sufficient statement of relevance, specifically MPEP §609 III(A)(3) on page 600-122 states where the information listed is not in the English language but was cited in a Search Report or other action by foreign patent office in a counterpart foreign application the requirement for a concise explanation of relevance can be satisfied by submitting an English language version of the Search Report which indicates the degree of relevance found by the Foreign Office and includes the indications on a Search Report of the category. Thus, Applicants did submit a Information Disclosure Statement that did comply with 37 C.F.R. §1.98(a)(3). However, for

the edification of the Examiner, forwarded with the Information Disclosure Statement filed herewith are abstracts for FR2769927 and EP 0773320.

### **III. REPLY TO REJECTIONS**

In the second item 7 of the Office Action, claim 3 is rejected under 35 U.S.C. §112, second paragraph. Specific language is cited as the basis for the rejection. Claim 3 is amended to obviate the rejection. Withdrawal of the rejection of claim 3 is respectfully requested.

In item 9 of the Office Action, claims 1, 3 and 5 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,388,862 to Edwards. The rejection is respectfully traversed.

Applicants respectfully submit that Edwards fails to disclose a paper based on a fiber composition, the paper comprising at least one multitone-effect watermark, wherein the watermark, when observed in transmitted light, has a set of pale zones arranged in the manner of a screened image, as recited in claim 1.

Edwards is directed towards a security article, such as a bank note, credit card, identity card or travel document, that includes a security element, where the security element includes a plurality of layers, some of which are light transmitting and others that are opaque (see Abstract). Thus, Edwards discloses a separate security element that is embedded within the security article with portions of the security element being exposed to the surface of the security article at spaced intervals along the length of the security element at windows or apertures in the security article, which may be security paper (see col. 2, lines 31-36). The separate security element is made of a plurality of separate layers made of differing materials. Specifically, opaque regions 2a and 2b are formed by selectively demetalizing a polyester film, while portions 3a and 3b are resist layers to prevent etching. Further, regions 4a and 4b

are thin layers of aluminum while reference numbers 6a, 6b identify transparent coatings (see Fig. 1, and col. 4, lines 16-59).

As noted, the opaque regions on the elongated security elements are formed by selectively demetalizing a polyester film metalized with aluminum (see col. 4, lines 27-30). In other words, the portions which transmit light and portions which are opaque are not made directly on the paper composition, as is the case in a watermark where it is part of a fibrous paper base. A watermark is defined as a translucent design impressed on paper during manufacturing visible when the finished paper is held to light (The American Heritage Dictionary Second College Edition), i.e., a watermark is impressed into the paper creating the portions which transmit light and portions which are opaque and does not include any additives. Thus, Edwards is distinguishable from claim 1. Further, claims 3 and 5, which depend from claim 1, are likewise distinguishable over the applied reference for at least the reasons discussed above and the additional features they recite. Withdrawal of the rejection of claims 1, 3 and 5 is respectfully requested.

In item 10 of the Office Action, claims 1 and 5 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,275,870 to Halope et al. (hereinafter "Halope"). The rejection is respectfully traversed.

Applicants respectfully submit that Halope fails to disclose a paper based on a fiber composition, the paper comprising at least one multitone-effect watermark, wherein the watermark, when observed in transmitted light, has a set of pale zones arranged in the manner of a screened image, as recited in claim 1.

Halope is directed towards a printable plastic support containing security markings which look like watermarks, which are referred as pseudo-watermarks (see col. 1, lines 5-7). The pseudo-watermarks are used when watermarks are difficult to form on sheets, i.e., plastic sheets. In fact, the pseudo-watermarks are different from conventional watermarks because

the pseudo-watermarks are in effect printed on the plastic sheets. Specifically, on a sheet of a synthetic material, pseudo-watermarks are printed by applying an opacity modifying composition at specific sites of a synthetic substrate (see col. 2, lines 8-30). Thus, Halope discloses a synthetic support comprising a mark consisting of at least one layer of a composition altering the substrate opacity. The substrate is a sheet consisting of at least one polyolefin (see col. 3, lines 32-33). Therefore, Halope fails to disclose a paper based on a fiber composition. Thus, Halope is distinguishable from claim 1. Further, claim 5, which depends from claim 1, is likewise distinguishable over the applied reference for at least the reason discussed above and for the additional feature it recites. Withdrawal of the rejection of claims 1 and 5 is respectfully requested.

In item 12 of the Office Action, claims 1, 2 and 4 are rejected under 35 U.S.C. §103(a) as unpatentable over Edwards. The rejection is respectfully traversed.

As discussed above, Applicants respectfully submit that Edwards fails to disclose the features recited in claim 1. Further, Applicants respectfully submit that Edwards fails to render obvious the subject matter as recited in claim 1 because a *prima facie* case of obviousness is not supported.

Applicants respectfully submit that Edwards fails to disclose paper based on a fiber composition, the paper comprising at least one multitone-effect watermark, wherein the watermark, when observed in the transmitted light, has a set of pale zones arranged in the manner of a screened image, as recited in claim 1. Edwards merely discloses a separate security element consisting of demetalized polyester film that has been metalized with aluminum (see col. 4, lines 27-30). As such, Applicants respectfully submit that claim 1 is distinguishable and is not obvious over Edwards. Furthermore, claims 2 and 4, which depend from claim 1, are likewise distinguishable over the applied reference for at least the reason

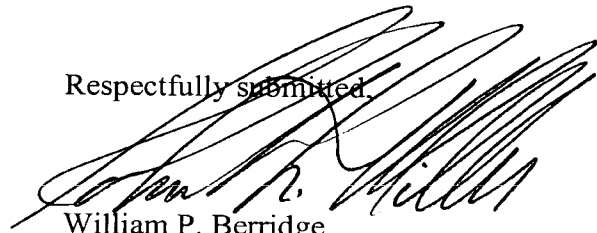
discussed above and for the additional feature they recite. Withdrawal of the rejection of claims 1, 2 and 4 is respectfully requested.

**IV. CONCLUSION**

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-19 are respectfully requested.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



William P. Berridge  
Registration No. 30,024

Robert A. Miller  
Registration No. 32,771

WPB:RAM:SSK/mmc

**Attachments:**

Appendix  
PTO Filing Receipt w/ Claim for Priority  
Petition for Extension of Time

Date: October 25, 2002

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

<p><b>DEPOSIT ACCOUNT USE AUTHORIZATION</b> Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
---------------------------------------------------------------------------------------------------------------------------------------------------------------------------



APPENDIX

Changes to Claims:

Claims 15-19 are added.

The following is a marked-up version of the amended claim 3:

3.     (Amended) Paper according to claim 1, wherein the watermark appears as a screened image whose screen marks are constituted for the most part constituted at least 50% by lines.